

Serial no. 09/524,076

Amendment in Resp. to Final Off. Action of June 5, 2003

UTILITY PATENT

B&D No. P-TN-1698

REMARKS

Claims 1 and 4 have been amended. Currently in the above-identified application therefore are Claims 1-11.

Applicant requests that the Examiner remove the finality of the present Office Action so that the evidence of patentability presented herein can be properly considered by the Examiner. Under the MPEP, a second office action shall be final "except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement." MPEP § 706.07(a), at 700-73 (8th ed., rev. 1, Feb. 2003).

In the present case, the examiner introduced a new ground of rejection, the anticipation by DE 197 06 408 ("DE '408") under 35 USC § 102(a). This was different than the previous rejection based on DE '408 under 35 USC § 102(b). This new ground was not necessitated by an amendment (as none was filed) or an information disclosure statement (as none was filed.)

The Examiner contends that the § 102(b) rejection was "obviously a typographical error and clearly intended as a rejection under" § 102(a). While the previous rejection may have been a typographical error, it was not obviously one as it referred to an existing statutory basis for rejection, rather than a non-existing one, e.g., § 102(v).

Furthermore, while the rejection may have been clear to the Examiner to be a rejection under § 102(a), such was not apparent to the Applicant. This is because, under present PTO rules,

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the Examiner's office action is supposed to accurately reflect the Examiner's rejections. According to the MPEP, the "goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." MPEP § 706, at 700-17. Under such policy, "the ground of rejection [needs to be] fully and clearly stated." MPEP § 707.07(d), at 700-112.

Because the Examiner did not clearly articulate the rejection, as admitted by the Examiner, Applicant did not have the opportunity to provide evidence of patentability, being that presenting such evidence now would be considered untimely due to the finality of the Office Action.¹ Applicant will nevertheless present such evidence in the hope that it is considered by the Examiner.

The Examiner has rejected Claims 1-11 under 35 USC § 102(a) and/or § 103(a) as unpatentable over DE 197 06 408 ("DE '408"). Reconsideration and withdrawal of these rejections are respectfully requested. Applicants will address the rejections to independent Claims 1 and 4 separately.

Claim 1, as amended, calls for a miter saw comprising a base assembly, a rotatable table rotatably connected to the base assembly, a nonremovable fence attached to the base assembly for supporting a workpiece, a rotatable table rotatably connected to the base assembly, the table

¹ Under MPEP § 715.09, an affidavit or declaration is considered untimely if its submitted after final rejection, unless it is submitted with a first reply after final rejection for the purpose of overcoming a new ground of rejection. Under such standard, the Examiner has placed Applicant in a Catch-22 situation. If the new rejection is not considered a new ground of rejection, any submitted declaration would be considered untimely. On the other hand, the new rejection is recognized in the future by the Examiner as a new ground of rejection, then now is the time to

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having a plane for supporting the workpiece, a saw assembly including a motor and a blade driven by the motor, and a pivot arm pivotally attached to the table and supporting the saw assembly, allowing a user to plunge the blade below the table plane, wherein area of the blade below the table plane when plunged is between about 14.4% and about 17.5% of total blade area.

Admittedly, DE '408 shows a miter saw comprising a base assembly, a rotatable table rotatably connected to the base assembly, the table having a plane, a saw assembly including a motor and a blade driven by the motor, and a pivot arm pivotally attached to the table and supporting the saw assembly, allowing a user to plunge the blade below the table plane. However, based on Figure 3 of DE '408, the area of the blade below the table plane when plunged is 18.22% of the total blade area.

By contradistinction, Claim 1 calls for the "area of the blade below the table plane when plunged [to be] between about 14.4% and about 17.5% of total blade area." According to the MPEP, a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131, at 2100-70 (*quoting Verdegaal Bros. v. Union Oil Co. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). Because DE '408 does not disclose plunging the blade so that the area of the blade below the table is about 14.4% and about 17.5% of the total blade area, DE '408 cannot anticipate Claims 1-3.

file such declaration. Being that Applicant cannot predict the Examiner's future actions, Applicant will nonetheless submit a declaration in the hope that it is considered by the Examiner.

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Furthermore, DE '408 discloses a fence disposed on the base assembly that can be removed and disposed in another position on the base assembly. By contradistinction, Claim 1 calls for "a nonremovable fence attached to the base assembly." Because DE '408 does not disclose such nonremovable fence, DE '408 cannot anticipate Claims 1-3.

In the alternative, the Examiner has also rejected Claims 1-3 based on DE '408 under 35 USC § 103(a) because "even if it is argued that [DE '408] lacks the specific dimensions, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use these specific dimensions or any dimensions depending upon the type and size of the intended workpiece, because it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art."

Admittedly, differences in ranges will not support the patentability of the claimed subject matter "unless there is evidence that such [range] is critical." See MPEP § 2144.05(II)(A), at 2100-138. In fact, the "law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims In such a situation, the applicant must show that the particular range is critical generally by showing that the claimed range achieves unexpected results relative to the prior art range." MPEP § 2144.05(III), at 2100-138 (*quoting In re Woodruff*, 16 USPQ2d 1934 (Fed. Cir. 1990)). Evidence of unexpected results (and thus of nonobviousness) includes evidence of superiority of a property shared with the prior art. MPEP § 716.02(b), at 700-240. Similarly, evidence of a property not possessed by the prior art is evidence of nonobviousness. *Id.*

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Applicant hereby attaches a declaration to provide nonobviousness evidence as to unexpected results. In the present case, having the area of the blade below the table when the blade is plunged be about 14.4% and about 17.5% of the total blade area is critical because a miter saw with such dimensions can cut certain desired workpiece with a smaller blade that were not previously achievable. With such arrangement, a ten-inch miter saw can cut both a 6.5" by ¾" workpiece and a dimensional 4" by 4" workpiece without removing the fence. By comparison, DE '408 discloses a ten-inch miter saw that, while it certainly can cut a 6.5" by ¾" workpiece as shown in Figure 5, it cannot cut a 4" by 4" workpiece without changing the position of the fence. Such step is not necessary in the ten-inch miter saw according to Claim 1.

The ability to cut the certain desired workpieces described above without removing the fence is a property not possessed by DE '408. Furthermore, the ability to cut a dimensional 4" by 6" workpiece with a ten-inch blade is a property superior to the prior art. Under the MPEP, these facts are evidence of nonobviousness over DE '408. Therefore Claims 1-3 are allowable over DE '408.

Claim 4, as amended, calls for a miter saw comprising a base assembly, a rotatable table rotatably connected to the base assembly, a nonremovable fence attached to the base assembly for supporting a workpiece, the table having a table plane, a fence connected to the base assembly and having a fence plane, a saw assembly including a motor and a blade driven by the motor, the blade having a radius and a blade center, and a pivot arm pivotally attached to the table and pivotally supporting the saw assembly about a first axis substantially parallel to the

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table plane, allowing a user to plunge the blade below the table plane, wherein distance between the first axis and the table plane is about 0.472 times the radius, distance between the first axis and the fence plane is about 1.45 times the radius, and distance between the first axis and the blade center is about 1.882 times the radius.

Admittedly, DE '408 shows a miter saw comprising a base assembly, a rotatable table rotatably connected to the base assembly, the table having a table plane, a fence connected to the base assembly and having a fence plane, a saw assembly including a motor and a blade driven by the motor, the blade having a radius and a blade center, and a pivot arm pivotally attached to the table and pivotally supporting the saw assembly about a first axis substantially parallel to the table plane, allowing a user to plunge the blade below the table plane. However, based on Figure 3 of DE '408, the distance between the first axis and the table plane is 0.57 times the radius and the distance between the first axis and the fence plane is 0.927 times the radius.

By contradistinction, Claim 4 calls for the "distance between the first axis and the table plane is about 0.472 times the radius, distance between the first axis and the fence plane is about 1.45 times the radius." According to the MPEP, a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131, at 2100-70. Because DE '408 does not disclose such dimensions, DE '408 cannot anticipate Claims 4-11.

Furthermore, DE '408 discloses a fence disposed on the base assembly that can be removed and disposed in another position on the base assembly. By contradistinction, Claim 4 calls for "a

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nonremovable fence attached to the base assembly." Because DE '408 does not disclose such nonremovable fence, DE '408 cannot anticipate Claims 4-11.

In the alternative, the Examiner has also rejected Claims 4-11 based on DE '408 under 35 USC § 103(a) because "even if it is argued that [DE '408] lacks the specific dimensions, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use these specific dimensions or any dimensions depending upon the type and size of the intended workpiece, because it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art."

Admittedly, differences in ranges will not support the patentability of the claimed subject matter "unless there is evidence that such [range] is critical." See MPEP § 2144.05(II)(A), at 2100-138. In fact, the "law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims In such a situation, the applicant must show that the particular range is critical generally by showing that the claimed range achieves unexpected results relative to the prior art range." MPEP § 2144.05(III), at 2100-138. Evidence of unexpected results (and thus of nonobviousness) includes evidence of superiority of a property shared with the prior art. MPEP § 716.02(b), at 700-240. Similarly, evidence of a property not possessed by the prior art is evidence of nonobviousness. *Id.*

In the present case, having an arrangement with the claimed dimensions is critical because a miter saw with such dimensions can cut certain desired workpiece with a smaller blade that were not previously achievable. With such arrangement, a ten-inch miter saw can cut both a 6.5"

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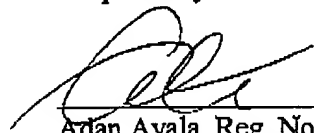
by $\frac{3}{4}$ " workpiece and a dimensional 4" by 4" workpiece without removing the fence. By comparison, DE '408 discloses a ten-inch miter saw that, while it certainly can cut a 6.5" by $\frac{3}{4}$ " workpiece as shown in Figure 5, it cannot cut a 4" by 4" workpiece without changing the position of the fence. Such step is not necessary in the ten-inch miter saw according to Claim 4.

The ability to cut the certain desired workpieces described above without removing the fence is a property not possessed by DE '408. Furthermore, the ability to cut a dimensional 4" by 6" workpiece with a ten-inch blade is a property superior to the prior art. Under the MPEP, these facts are evidence of nonobviousness over DE '408. Therefore Claims 4-11 are allowable over DE '408.

In view of the foregoing, all the claims are patentable and the application is believed to be in condition for formal allowance. Reconsideration of the application and allowance of Claims 1-11 are respectfully requested.

No fee is due for the present amendment. Nevertheless, the Commissioner is authorized to charge payment of any fees due in processing this response, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



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